

Amend claim 5 with the clean version provided immediately below to read as follows:

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D17  
5 (Twice Amended). A probe comprising an oligomer selected from the group consisting of SEQ ID NOs: 4-19.

### REMARKS

This is in response to the Office Action mailed November 23, 2001, for which an unextended response is due February 23, 2002. Enclosed herewith is a Petition for a One-Month Extension of Time and the appropriate fee. The specification has been amended to incorporate into the first page a claim for priority made under Title 35, United States Code, Section 119 to Great Britain Application Number 9827016.8, filed on December 8, 1998, now abandoned. Incorporation of this statement is supported by the Declaration and Power of Attorney submitted with the filing of the instant application. A certified copy of the priority application is herein enclosed. Claims 3 and 5 have been amended; with support for claim 5 to be found, *inter alia*, on page 1, lines 27-28 and in original Figure 3. Presently, Claims 1-3, 5-10, 12, 13, 15 and 16 are pending. No new matter has been added.

Consistent with 37 C.F.R. §1.121, a version of the amended disclosure with markings to show changes resulting from the above amendments is presented at the end of this response.

Applicants respectfully request reconsideration of the application in view of the foregoing amendments and the following remarks.

### **PRIORITY**

The instant application is objected to for allegedly not complying with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. §119. In particular, a certified copy of the priority Great Britain Application is stated not to have been submitted. Applicants respectfully traverse.

Applicants herein enclose a certified copy of Great Britain Application Number 9827016.8, filed on December 8, 1998, now abandoned. A proper claim under 35 U.S.C. §119 should, thus, be secured.

Applicants, thus, respectfully request the reconsideration and withdrawal of this objection.

### **SEQUENCE RULES COMPLIANCE**

The application is objected to for failure to comply with the requirements of 37 C.F.R. 1.821 through 1.825. Particularly, SEQ ID NO: 2 is said to comprise a region of approximately 60 residues beginning at position 89 that consists of amino acids whose single letter abbreviation is either A, T, C, or G. Applicants respectfully traverse.

Applicants were unable to identify in either the hard copy or the computer-readable copy the region within SEQ ID NO: 2 wherein a stretch of nucleotide symbols existed. Applicants, therefore, resubmit the Sequence Listing originally submitted on March 26, 2001 in computer-readable and hard copy. Applicants respectfully request that the Examiner encircle the region on the Sequence Listing wherein the stretch of nucleotide sequences is found within SEQ ID NO: 2 and the appropriate corrections will be made.

Applicants, therefore, respectfully request the reconsideration and withdrawal of the instant objection.

### **35 U.S.C. §101, UTILITY**

Claim 1 is rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter. Specifically, claim 1 is said not to require that the claimed complement of a polynucleotide encoding a polypeptide of SEQ ID NO: 2 be isolated (*e.g.*, recombinant). Applicants respectfully traverse.

A Preliminary Amendment was submitted on December 8, 1999 along with the filing of the instant application. Claim 1 was amended therein to require that the polynucleotide disclosed within Claim 1 was "recombinant". Applicants, thus, respectfully take the position that this is statutory subject matter in accordance with 35 U.S.C. §101.

Accordingly, Applicants respectfully request the reconsideration and withdrawal of the instant rejection.

### **35 U.S.C. §112, SECOND PARAGRAPH**

Claims 2 and 5 are rejected under 35 U.S.C. §112, second paragraph, as indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Applicants respectfully traverse.

Claim 2 is specifically rejected because of language therein to “a portion” of the polynucleotide or complement. Applicants respectfully traverse. Applicants were not able to identify the alleged language within claim 2. Claim 3 was found to recite this language. Therefore, Applicants address the rejection as though it were applied to claim 3. If this is incorrect, Applicants will readdress the issue in the next response.

Claim 3 has been amended to remove the language in order to facilitate prosecution on the merits in a manner consistent with the PTO’s Patent Business Goals (PBG), 65 Fed. Reg. 54603 (September 8, 2000); notwithstanding Applicants’ belief that the claims are allowable as originally filed. Applicants, therefore, respectfully take the position that the amendment does not narrow the scope of claim 2 within the meaning of *Festo*.

Applicants, therefore, respectfully request the reconsideration and withdrawal of the instant rejection as to Claim 2.

Claim 5 is specifically rejected because the claim employs the language “specific to” in reference to the claimed probe. Applicants respectfully traverse.

Claim 5 has been amended to remove the language therefrom in order to facilitate prosecution on the merits in a manner consistent with the PTO’s Patent Business Goals; notwithstanding Applicants’ belief that the claims are allowable as originally filed. Applicants, therefore, respectfully take the position that the amendment does not narrow the scope of claim 5 within the meaning of *Festo*.

As amended, the claim is drawn to a specific set of probes disclosed in SEQ ID NOs: 4-19 for which support can be found, *inter alia*, on page 1, line 27-28, and in original Figure 3.

Applicants, therefore, respectfully request the reconsideration and withdrawal of the instant rejection as to Claim 5.

### **35 U.S.C. §112, FIRST PARAGRAPH**

Claims 3 and 5 are rejected under 35 U.S.C. §112, first paragraph, because the specification, while being enabling for polynucleotides encoding a polypeptide of SEQ ID NO: 2, and for polynucleotides consisting of a fragment of said polynucleotides, and for polynucleotides consisting of said fragments and a heterologous polynucleotide (*e.g.*, vector), does not reasonably provide enablement for polynucleotides comprising a portion of said polynucleotides wherein the polynucleotide is other than that encoding SEQ ID NO: 2. Applicants respectfully traverse.

Claims 3 and 5 have been amended in order to facilitate prosecution on the merits in a manner consistent with the PTO’s Patent Business Goals; notwithstanding Applicants’ belief that

the claims are allowable as originally filed. Applicants, therefore, respectfully take the position that the amendment does not narrow the scope of the claims within the meaning of *Festo*.

As amended, claim 3 is drawn to a recombinant polynucleotide comprising the complement of the polynucleotide of claim 2; and claim 5 is drawn to a specific set of probes disclosed in SEQ ID NOs: 4-19; support to be found, *inter alia*, on page 1, line 27-28, and in original Figure 3.

Applicants, therefore, respectfully request the reconsideration and withdrawal of the instant rejection as to claims 3 and 5.

### 35 U.S.C. §102, ANTICIPATION

Claims 1, 3, 5, 7, 8, and 9 are rejected under 35 U.S.C. §102(a) as being anticipated by Caterina *et al.*, 1999 *Nature* 398:436-441. Caterina is said to disclose polynucleotides comprising the coding region of the polynucleotide of SEQ ID NO: 1, probes specific to said polynucleotide and methods of making a polypeptide. Applicants respectfully traverse.

The instant application claims priority under Title 35, United States Code, §119 of Great Britain Application Number 9827016.8, filed on December 8, 1998, now abandoned. Said claim is supported by the Declaration and Power of Attorney submitted with the filing of the instant application.

Given that the priority filing predates that of the above-cited reference, Applicants submit that the disclosure of Caterina is not appropriate prior art for use in a §102 rejection.

Applicants, thus, respectfully request the reconsideration and withdrawal of the instant rejection.

Claims 3 and 5 are rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 5,834,183. U.S. Patent No. 5,834,183 is said to disclose a portion of SEQ ID NO: 1 and, therefore, anticipate claims 3 and 5 reciting language claiming a "portion" or "oligomer" of SEQ ID NO: 1. Applicants respectfully traverse.

Claims 3 and 5 have been amended in order to facilitate prosecution on the merits in a manner consistent with the PTO's Patent Business Goals. As drafted, the claims no longer contain the language deemed to be anticipated by the cited patent.

Accordingly, Applicants respectfully request the reconsideration and withdrawal of the instant rejection.


Claims 3 is rejected under 35 U.S.C. §102(b) as being anticipated by the SIGMA Product Catalogue, 1992. The Catalogue is said to disclose oligodeoxyadenylic acid consisting of AAA; *see* page 743, product O4253. This is asserted to be portion of SEQ ID NO: 1 and, therefore, anticipate claim 3 by reason of the language claiming a "portion" of SEQ ID NO: 1. Applicants respectfully traverse.

Claim 3 has been amended in order to facilitate prosecution on the merits in a manner consistent with the PTO's Patent Business Goals and as drafted, no longer contains the language deemed to be anticipated by the cited patent.

Applicants, therefore, respectfully request the reconsideration and withdrawal of the instant rejection.

In summary, Applicants maintain all claims are in condition for allowance and a favorable action on the merits is earnestly solicited.

Respectfully submitted,

By   
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**VERSION OF AMENDED CLAIMS WITH MARKINGS**  
**TO SHOW CHANGES MADE**

In the Claims

Claim 3 (Twice Amended). A recombinant polynucleotide comprising the complement of the polynucleotide of Claim 2 ~~or a portion thereof~~.

Claim 5 (Twice Amended). A probe comprising an oligomer selected from the group consisting of SEQ ID NOs: 4-19 ~~specific to the polynucleotide of Claim 2~~.